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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/855,971	05/15/2001	Takao Omachi	NEC N01268	1601
27667	7590	02/08/2006	EXAMINER	
HAYES, SOLOWAY P.C. 3450 E. SUNRISE DRIVE, SUITE 140 TUCSON, AZ 85718			LAYE, JADE O	
			ART UNIT	PAPER NUMBER
			2617	

DATE MAILED: 02/08/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/855,971

Applicant(s)

OMACHI, TAKAO

Examiner

Jade O. Laye

Art Unit

2617

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 01 December 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-19 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Response to Amendment

I. Applicant's claim amendments, dated 12/1/05, have been entered and made of record. Accordingly, the objections applied in the previous Non-Final Action are hereby withdrawn.

Response to Arguments

II. Applicant's arguments with respect to all amended claims have been considered but are moot in view of the new ground(s) of rejection. Accordingly, **THIS ACTION IS MADE FINAL.**

Claim Rejections - 35 USC § 103

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

III. Claims 1, 3, 7, 13, and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over *Wilkins* (US Pat. No. 5,466,919) in view of *Dedrick*. (US Pat. No. 5,717,923).

As to claim 1, *Wilkins* discloses a system for transmitting and receiving commercial messages ("CM") and/or advertisements comprising a broadcast station terminal, which transmits a plurality of compressed audiovisual signals (i.e., scaled-down and synthesized images/voices). The system also comprises a transmitting device used to modulate said audiovisual signal and a receiving terminal, which automatically selects a commercial message

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based upon a subscriber's profile. Lastly, the transmitted CM's contain identification information, such as that described at Column 11, Lines 27-38. (Abstract; Col. 2, Ln. 44-53; Col. 8, Ln. 42-61; Col. 9, Ln. 13-19; Col. 6, Ln. 43-67; col. 17, Ln. 14-22; Col. 9, Ln. 32-40; Col. 10, Ln. 1-11; Col. 11, Ln. 27-38).

But, *Wilkins* fails to disclose a viewer attribute setting device, which is used by the viewer to set his or her attributes (e.g., age and sex) in advance. However, within the same field of endeavor, *Dedrick* discloses a similar system having a graphical user interface whereby the user is allowed to set personal attributes (i.e., age, sex, and other preferences) in advance. (Abstract; Col. 3, Ln. 37-Col. 4, Ln. 10). Accordingly, it would have been obvious to one having ordinary skill in this art at the time of Applicant's invention to combine the systems of *Wilkins* and *Dedrick*, thereby providing the user with more control and/or privacy over his or her profile attributes.

Claim 13 corresponds to the system claim 1. Thus, it is analyzed and rejected as previously discussed.

Claim 3 recites the system of claim 1, further comprising limitations too numerous to recite herein. (refer to claim sheet). As to claim 3, *Wilkins* further discloses transmitting digital CM/identification information within the vertical blanking interval ("VBI"). (Col.,2, Ln. 31-40; Col. 6, Ln. 49-58; Col. 8, Ln. 43-55). Moreover, in digital transmission, it is inherent to transmit data in packets.

Regarding the limitation addressing analog transmission, the Examiner takes Official Notice that, at the time of Applicant's invention, it was notoriously well-know in the art to utilize analog transmission. Accordingly, it would have been obvious to one having ordinary skill in

this art at the time of applicant's invention to further modify the combined systems of *Wilkins* and *Dedrick* to also include analog transmission, thereby enabling the system to be available to a broader range of subscribers. *[Note: At Col. 6, Ln. 49-58, one could argue that analog transmission is discussed because Wilkins specifically states the system also includes "future digital video systems." Therefore, one could infer the system, in general, is addressing analog transmissions.]*

Claim 15 corresponds to the system claim 3. Thus, it is analyzed and rejected as previously discussed.

As to Claim 7, *Wilkins* further teaches the system can also be controlled via a user's manual input. (Col. 10, Ln. 26-40). To clarify the Examiner's interpretation, *Wilkins* teaches the viewed channels (which contain commercial messages (Col. 9, Ln. 20-21)) can be determined by the viewer's channel selection. The remainder of Claim 7's limitations are encompassed within Claim 1. Accordingly, the combined systems of *Wilkins* and *Dedrick* disclose all limitations of claim 7.

[Note: Although not relied upon to reject Claim 7, Hendricks et al, US Pat. No. 5,990,927, disclose a set top terminal which allows the user to manually select commercials. (Col. 22, Ln. 29-33).]

IV. Claims 2, 4, 6, 8, 14, and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over *Wilkins* in view of *Dedrick*, as discussed under Claim 1, and further in view of *Wachob*. (US Pat. No. 5,155,591).

Claim 2 recites the system of claim 1, and further limitations too numerous to recite herein (refer to claim sheet). As discussed above, the combined systems of *Wilkins* and *Dedrick* render obvious all limitations of Claim 1, but fail to specifically disclose those of Claim 2. However, within the same field of endeavor, *Wachob* discloses a similar system wherein the receiving terminal (i.e., set top box) transmits CM/Identification information to the headend (i.e., advertising terminal) in order to provide statistical data. (Abstract; Col. 1, Ln. 39-55; Col. 2, Ln. 43-49; Col. 8, Ln. 17-66; Col. 10, Ln. 27-43). Accordingly, it would have been obvious to one having ordinary skill in this art at the time of applicant's invention to combine the systems of *Wilkins*, *Dedrick*, and *Wachob* in order to provide a system which maintains real-time records of demographic characteristics of subscribers and the programs they watch.

Claim 8 corresponds to Claim 2. Thus, it is analyzed and rejected as previously discussed.

As to claim 4, *Wilkins* further discloses the system is capable of switching between alternate commercials (i.e., cutting) and capable of two-way transmission, thereby allowing communication of certain data back to the headend (i.e., advertiser terminal). (Col. 6, Ln. 37-42; Col. 8, Ln. 4-40; Col. 11, Ln. 27-39). Moreover, the system also inherently expands the transmitted data because it can be compressed before transmission. (as discussed under the rejection of claim 1). If the data is compressed, it must be decompressed (i.e., expanded) before it can be displayed. The remainder of the limitations are either inherent (such as the speaker) or were encompassed within claim 1. Accordingly, the combined systems of *Wilkins*, *Dedrick*, and *Wachob* disclose all limitations of claim 4.

Claim 6 is encompassed within the limitations of Claim 2. Thus, it is analyzed and rejected as discussed therein.

The limitations of Claim 14 are combinations of limitations recited in Claims 1, 4 and 6. Thus, it is analyzed and rejected as discussed therein.

The limitations of Claim 19 are combinations of limitations recited in Claims 1 and 7. Thus, it is analyzed and rejected as discussed therein.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jade O. Laye whose telephone number is (571) 272-7303. The examiner can normally be reached on Mon. 7:30am-4, Tues. 7:30-2, W-Fri. 7:30-4.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Chris Kelley can be reached on (571) 272-7331. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Examiner: Jade O. Laye

Initials: JO

February 2, 2006.

A handwritten signature in black ink, appearing to read 'Vivek Srivastava', with a long horizontal line extending from the end of the signature.

**VIVEK SRIVASTAVA
PRIMARY EXAMINER**